| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/965,429 | 09/27/2001 | Salah Obied | 47079-0105 | 3630 |

| | | | | EXAMINER |
|---|---|---|---|---|
| 30223 | 7590 | 04/06/2006 | | FOWLKES, ANDRE R |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2192 | |

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| | 09/965,429 | OBIED ET AL. |
| **Office Action Summary** | Examiner | Art Unit | |
| | Andre R. Fowlkes | 2192 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>11 January 2006</u>.

2a)☒ This action is **FINAL.**    2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1,2,4-12,35-37 and 40-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-12,35-37 and 40-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.      This action is in response to the amendment filed 1/11/06.


2.      Claims 1, 2, 4-12, 35-37 and 40-44 are pending.  Claims 1, 5, 11, 12 and 35-37

have been amended.  Claims 13, 15-24, 26-34, 38 and 39 have been canceled.  New

claims 40-44 have been added.


### Claim Rejections - 35 USC § 112

3.      The rejection of claims 1, 2, 4-13, 15-24 and 26-36 under 35 U.S.C. 112 is

withdrawn in view of applicant's amendment.


### Claim Rejections - 35 USC § 102

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


5.      Claims 1, 2, 4-12, 35-37 and 40-44 are rejected under 35 U.S.C. 102(b) as being

anticipated by Quatrani, "Visual Modeling with Rational Rose 2000 and UML", ISBN: 0-

201-69961-3.


As per claim 1, Quatrani discloses: a **method comprising:**

- **presenting a** software application **having a randomly selected outcome, wherein the** software application **is presented by executing software code, at least one portion of the software code generated by a software development tool,** (p. 16 line 7-8, "the Rational Rose product family is designed to provide the software developer with a complete set of visual modeling tools for development of ... (any kind of software applications)"), **the generation including:**

- **preparing an analysis model for the** software application, **the analysis model describing functionality to be included in the software code** (p. 13 line 15 – p. 14 line 5, "Structuring the project (using the software development tool) ... includes the following activities:

- Requirements-a narration of the system vision along with a set of functional and non functional requirements (i.e. an analysis model)"),

- **preparing a design model for the** software application, **the design model including a plurality of objects for realizing the functionality in the analysis model** (p. 13 line 15 – p. 14 line 5, "Structuring the project (using the software development tool) ... includes the following activities:

- Business Modeling-the identification of desired system capabilities and user needs (and objects)

- Analysis and Design (Models)- a description of how the system will be realized in the implementation phase (including a plurality of objects)", and software engineering principles specify that the design is based on the analysis of the solution),

- **wherein the design model defines static relationships between the objects and dynamic behavior of the objects** (p. 36 line 2-5, "uses cases and scenarios (i.e. object model diagrams) provide a way to describe (static) system behavior; that is, the interaction between objects in the system ...A state chart diagram shows the ... events or messages that cause a transition from one state to another, and the actions that result from a state change (i.e. dynamic relationships between objects)"),

- **generating, from the design model, the at least one portion of the software code, and receiving an** input **associated with the** software application (p. 13 line 15 – p. 14 line 5, "Structuring the project (using the software development tool) ... includes the following activities: -Implementation- the production of the code, (from the design model) ,that will result in an executable system", and the compiler responds to the request to produce code nearly simultaneously with the corresponding input.

As per claim 2, the rejection of claim 1 is incorporated and further, Quatrani discloses that **the analysis model, the design model, and the software code are prepared using the software development tool** (p. 13 line 15 – p. 14 line 5, "Structuring the project (using the software development tool) ... includes the following activities:

- Business Modeling-the identification of desired system capabilities and user needs

- Requirements-a narration of the system vision along with a set of functional and

non functional requirements

- Analysis and Design (Models)- a description of how the system will be realized

in the implementation phase

-Implementation-the production of the code that will result in an executable

system").


As per claim 4, the rejection of claim 3 is incorporated and further, Quatrani

discloses that **the design model includes object model diagrams and state charts,**

**the object model diagrams defining the static relationships between the objects**

(p. 36 line 2-3, "uses cases and scenarios (i.e. object model diagrams) provide a way to

describe (static) system behavior; that is, the interaction between objects in the

system"), **the state charts defining the dynamic behavior of the objects** (p. 36 line

4-5, "A state chart diagram shows the ... events or messages that cause a transition

from one state to another, and the actions that result from a state change").


As per claim 5, the rejection of claim 1 is incorporated and further, Quatrani

discloses that **the functionality described by the analysis model is organized into**

**use cases, the use cases being selected from the group consisting of handling**

**money, playing the wagering game, handling critical events, and servicing a**

**wagering game machine** (p. 20 line 2-3, "The behavior of the system under

development (i.e., what functionality must be provided by the system (the analysis

model)) is documented in a use case model that illustrates the system's intended

functions (use cases)", and Rational Rose is a system involving use cases that are

created and selected for use depending on each type of application. For example, to

create a banking program, using Rational Rose, one would have use cases for handling

money and handling critical events).

As per claim 6, the rejection of claim 5 is incorporated and further, Quatrani

discloses that **the analysis model includes use case diagrams and sequence**

**diagrams** (p. 24 line 2-5, "sequence diagram ... use case), **the use case diagrams**

**defining relationships between the use cases and external actors outside the**

software application, **the sequence diagrams defining a sequence of interactions**

**between the use cases and the external actors** (p. 24 line 2-5, "A sequence diagram

shows object interactions, (e.g. interactions between use case and the external actors),

arranged in time sequence. It depicts the objects and classes involved in the scenario

and the sequence of messages exchanged between the objects needed to carry out the

functionality of the scenario. Sequence diagram typically are associated with the use

case realizations, (which define relationships between the use cases and external

actors), in the logical view of the system under development.").

As per claim 7, the rejection of claim 1 is incorporated and further, Quatrani

discloses that **the analysis model and the design model conform to the Unified**

**Modeling Language (UML) standard** (p. 10 line 10-11, "The Unified Modeling

Language (UML) provides a very robust notation which grows from analysis into design (modeling)").

As per claim 8, the rejection of claim 1 is incorporated and further, the additional limitation of this claim, (that the application created using this system is a **slot reel game including a plurality of symbol-bearing reels that are rotated and stopped to place symbols on the reels in visual association with a display area**), is directed toward non-functional descriptive material, in that the specific type of software created with this software development system is merely non-functional descriptive material. Non functional descriptive material cannot render non-obvious an invention that would have otherwise been obvious (In re Gullack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Circ. 1983)).

As per claim 9, the rejection of claim 1 is incorporated and further, Quatrani discloses that **the software code includes another portion that is manually prepared** (p. 18 line 22, "use round-trip engineering facilities to (automatically) keep your designs synchronized with your (manual and automatically generated) code").

As per claim 10, the rejection of claim 9 is incorporated and further, Quatrani discloses that **the objects are associated with operations** (p. 22 line 10, "(object) behavior is implemented by the set operations for the object"), **the manually prepared portion of the software code defining the operations** (p. 18 line 22, "use round-trip

engineering facilities to (automatically) keep your designs synchronized with your

(manual and automatically generated) code", and the user chooses which code to

prepare manually).

As per claim 11, the rejection of claim 1 is incorporated and further, Quatrani

discloses the step of **modifying the design model and automatically modifying the**

**software code in response to modifying the design model** (p. 18 line 22, "use

round-trip engineering facilities to (automatically) keep your designs synchronized with

your code").

As per claim 12, the rejection of claim 1 is incorporated and further, Quatrani

discloses **modifying the software code and automatically modifying the design**

**model in response to modifying the software code** (p. 18 line 22, "use round-trip

engineering facilities to (automatically) keep your designs synchronized with your

code").

As per claims 35, this is another method version of the claimed method

discussed above, in claims 1, 5 & 11, wherein all claimed limitations have also been

addressed and/or cited as set forth above.  For example, see Quatrani's Visual

Modeling with Rational Rose 2000 and UML (p. 10 line 10 – 36 line 5).

As per claims 36, this is another method version of the claimed method

discussed above, in claims 1, 5, 12 & 37, wherein all claimed limitations have also been

addressed and/or cited.  For example, see Quatrani's Visual Modeling with Rational

Rose 2000 and UML (p. 10 line 10 – 36 line 5).


As per claim 37, the rejection of claim 6 is incorporated and further, Quatrani

discloses that **the external actors are selected from the group consisting of: a**

**player, a money handling function, a host and a random number generator**, (p. 20

line 2-3, "The behavior of the system under development  (i.e., what functionality must

be provided by the system (the analysis model)) is documented in a use case model

that illustrates the system's intended functions (use cases)", and Rational Rose is a

system involving use cases and actors that are created and selected for use depending

on each type of application.  For example, to create a banking program, using Rational

Rose, one would have actors for a player (i.e. a client), and a money handling function).


As per claim  40, this is a machine readable medium version of the claimed

method discussed above, in claim 1, wherein all claimed limitations have also been

addressed and/or cited.  For example, see Quatrani's Visual Modeling with Rational

Rose 2000 and UML (p. 10 line 10 – 36 line 5).


As per claims 41-44, this is a machine version of the claimed method discussed

above, in claims 2, 6-8 & 37, wherein all claimed limitations have also been addressed

and/or cited.  For example, see Quatrani's Visual Modeling with Rational Rose 2000

and UML (p. 10 line 10 – 36 line 5).


### Response to Arguments

6.     Applicants arguments have been considered but they are not persuasive.


*In the remarks, the applicant has argued substantially that:*

1)     Quatrani does not disclose "presenting a wagering game having a randomly

selected outcome" or "receiving a wager associated with the wagering game", at p.

12:5-9.


*Examiner's response:*

1)     Quatrani discloses preparing a software application (i.e. a wagering game with a

randomly selected outcome) and providing input (i.e. a wager) to the software

application.  The limitations "a wagering game", "a wager" and the specific features and

type of game, are non-functional descriptive material.  Non functional descriptive

material cannot render non-obvious an invention that would have otherwise been

obvious (In re Gullack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Circ. 1983)).


### Conclusion

7.     Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andre R. Fowlkes whose telephone number is (571)

272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

ARF

*Chameli C. Das*

**CHAMELI C. DAS**
**PRIMARY EXAMINER**

4/3/0 6,